IN THE

SUPREME COURT OF THE UNITED STATES

OCTOBER TERM, 1975

No. 75-1045

CORNING GLASS WORKS, *Petitioner*

v.

FISCHER & PORTER COMPANY, *Respondent*

PETITIONER'S REPLY BRIEF

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TABLE OF CITATIONS

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Respondent incorrectly argues on page 2 of its brief that ". . . petitioner is asking this Court to decide factually pregnant questions of non-joinder or misjoinder of inventorship and other highly technical questions concerning the effective date of prior art" and that "The very questions presented to this Court were presented to the jury. . . ." This incorrectly states the point of the petition.

Fact questions on the issues of inventorship and effective date of the more relevant prior art were presented by the evidence to be weighed by the jury. Over petitioner's objections, the instructions given to the jury failed to state the governing law so as to enable the jury to understand the law applicable to these matters presented by the evidence. The jury was accordingly left to assume that the presumption of validity had not been overcome.

The purpose for which this Court is being petitioned for a writ of certiorari is not what respondent imputes to petitioner (*i.e.* to decide factual questions); rather it is to review the question whether complete and correct instructions as to the applicable law on the two issues,

each underlying the ultimate issue of validity, were required for due process, and whether, despite the timely objections, incorrect instruction in one case and the failure to even provide instruction in the other case deprived petitioner of a fair trial.

Respondent also incorrectly argues at page 4 that there is an ". . . almost total lack of any public interest inherent in this case. . . ." To the contrary, there is inherent public interest in obtaining a ruling that a jury must be correctly instructed as to the law's requirements on each issue presented for determination. There could hardly be a matter more fundamental to our system of trial by jury, and a ruling is needed that this applies no less to a patent case than to other fields of law.

The public interest inherent in this case has a further aspect, namely, the public needs to be protected from reliance by the patentee on an invalid patent. In *Aero Spark Plug Co. v. B. G. Corporation*, 130 F.2d 290, 294 (2 Cir., 1942) Judge Frank observed that "An invalid patent masquerading as a valid one is a public menace. . . ."[1] As this Court stated in *Sinclair & Carroll Co. v. Interchemical Corp.*, 325 U.S. 327, 330 (1945):

> "It has come to be recognized, however, that of the two questions [infringement and validity], validity has the greater public importance, Cover v. Schwartz, 2 Cir., 133 F. 2d 541 [,545], and the District Court in this case followed what will usually be the better practice by inquiring fully into the validity of this patent."

1. In the *Aero* case, Judge Frank went on to state:

"It is no adequate answer to say that courts should not concern themselves with the protection of persons not parties to suits pending before them. The fact is that courts daily do so concern themselves, and in circumstances where the desirability of doing so is far less obvious than here and the means far less effective. Because I think that to hold invalid a patent which is obviously void is a matter of *major public importance*. . . ." (emphasis added)

This is no mere academic matter in the present case. Respondent's patent issued March 10, 1959; it expires March 10, 1976. The statute of limitations on patent infringement suits is 6 years (35 U.S.C. §286). Upon obtaining a judgment based upon the verdict of the incorrectly instructed jury in the present case, respondent instituted suits under this patent against other producers of Teflon-plug glass-barrel stopcocks, two of whom (Kontes Glass Co. and Lurex Manufacturing Co., Inc.) had been making such products ever since 1951 and 1952, *i.e.*, from several years before respondent Fischer & Porter even found out how to make Teflon-plug glass-barrel stopcocks.[2]

Thus, contrary to respondent's contentions, (a) the issue presented for this Court to decide is not "factually pregnant questions" but a question of necessary instruction of the jury as to the governing law, and (b) there is substantial public interest in this case. Accordingly, the petition should be granted.

Respectfully submitted,

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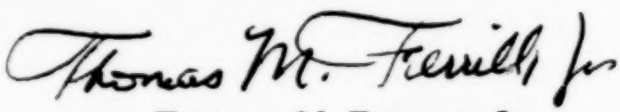
February 27, 1976

2. This Court is requested to take judicial notice of Fischer & Porter's suits filed February 27, 1975, against Kontes Glass Co. and March 21 1975, against Lurex Manufacturing Co., Inc. in the District Court for the District of New Jersey, Civil Actions Nos. 75-0339 and 75-0472, respectively, charging infringement of the patent here involved.

CERTIFICATION OF SERVICE

I, THOMAS M. FERRILL, JR., Attorney for Petitioner Corning Glass Works, hereby certify that forty copies of Petitioner's Reply Brief are being mailed to the Supreme Court of the United States, Washington, D. C. on February 27, 1976.

I also certify that three copies of the Reply Brief are being mailed to the offices of Jay Tolson, Esq., Six Penn Center Plaza, Philadelphia, Pa. on February 27, 1976. In addition, three copies are being mailed first class, postage pre-paid, to John M. Calimafde, Esq., New York, N. Y. on February 27, 1976.



THOMAS M. FERRILL, JR.